

Attorney Docket No.: J2071(C)  
Serial No.: 10/559,115  
Filed: June 8, 2006  
Confirmation No.: 1305

### **REMARKS**

Applicants wish to thank the Examiner for the keen review of the present patent application. Regarding the amendments, Applicants submit that support for the amendments may be found, among other places, on pages 3 and 6 of the specification as originally filed. Therefore, all amendments comply with 35 USC §132 and no new matter has been added.

#### **I Rejection Under 35 USC §112, Second Paragraph**

The Examiner has rejected claim 6 under 35 USC §112, second paragraph, and alleges that the same is indefinite for failing to particularly point out distinctly claim the subject matter which Applicants regard as the invention. Particularly, the Examiner notes that it is unclear and indefinite with respect to the claim language describing a precursor of niacin and niacinamide.

In view of the Examiner's comments, Applicants have amended claim 6 to identify additional skin lightening agents. In view of this, Applicants submit that the rejection made under 35 USC §112, paragraph 2 should be withdrawn and rendered moot.

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II. Rejection Under 35 USC §103

The Examiner has rejected claims 1-8 under 35 USC §103 as being unpatentable over Patent Abstracts of Japan, Publication No. JP 2003-055184 (hereinafter, '184) in view of Deckner et al., U.S. Patent No. 5,968,528 (hereinafter, '528). In the rejection, the Examiner mentions, in summary, that the '184 reference describes skin care compositions with bleaching action wherein the skin care compositions have extracts from the plant *Symplocos recemosa*. The Examiner mentions that the extract may come from bark or other parts of plants and that it can have excellent oxygen scavenging activity. The Examiner continues and mentions that the '528 reference describes compositions with Vitamin B3 and plants of genus *Rubia*, particularly *Rubia cordifolia*.

In view of the above, the Examiner believes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the instant ingredients for their known benefits since each is well known in the art for the same purpose and reason. Thus, the Examiner believes that the rejection made under 35 USC §103 is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicants' position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

The present invention, as now presented in independent claim 1, is directed to a cosmetic skin lightening composition comprising 0.1 to 50% by wt. of extracts of plants

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from the *genera Symplocos and Rubia*, the extract of *Symplocos* being selected from *Symplocos recemosa*, *Symplocos paniculata*, *Symplocos cochinchinesis* or mixtures thereof and the extract of *Rubia* being *Rubia cordifolia* wherein the extracts are primary skin lightening agents within the composition.

The invention of claim 1 further defined by the dependent claims, which claim, among other things, that sunscreen may be employed and the amount of sunscreen, that secondary skin lightening agents may be employed, specific extract that may be employed, the type of sunscreen that may be employed, the type of secondary skin lightening agent that may be employed, and the additional types of extracts that may be used. New claim 9 further characterizes the composition of claim 1 in that the secondary skin lightening agent that may be employed is niacin, niacinamide, or niacinamide ascorbate.

In contrast, the '184 reference merely discloses that an extract from the plant of the *genus Symplocos* may be used in a skin care preparation that exhibits anti-aging benefits and bleaching actions. The reference fails in every way to specifically describe all of the specific *Symplocos* extracts set forth in the claimed invention. Moreover, the reference is deficient in that it fails in every way to describe the extract of *Rubia* used in conjunction with *Symplocos* extract.

In an attempt to cure the vast deficiencies of the primary reference, namely the '184 reference, the Examiner relies on the '528 reference which merely mentions that extract in the genus *Rubia*, particularly *Rubia cordifolia* can be used as a natural anti-inflammatory agent. There is no teaching whatsoever in the '528 reference that even

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remotely suggests an extract of *Rubia* will yield excellent skin lightening benefits when used in conjunction with extract of *Symplocos*. Moreover, there is no teaching whatsoever in the references relied on by the Examiner that even remotely suggest the synergistic benefits the inventors have observed when using a mixture of the aforementioned abstracts. Applicants wish to direct the Examiner's attention to, for example, Table 1 of the specification as originally filed wherein it is shown that a combination of *Rubia* and *Symplocos* show a synergistic reduction in the amount of melanin formed in a culture of melanocytes. Moreover, the data in Table 2 of the specification clearly shows that *Rubia* and *Symplocos* extracts alone and in combination with one another decrease the uptake of melanin by keratinocytes as proven via testing with HaCaT keratinocytes in culture.

In view of the above, it is clear that all the important and critical limitations set forth in the presently claimed invention are not found in the combination of references relied on by the Examiner. Therefore, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that all claims of record are in condition for allowance.

Reconsideration and favorable action are earnestly solicited.

Applicants welcome comments from the Examiner so that prosecution of the instant application may be expedited.

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In the event the Examiner has any questions concerning the present patent application, the Examiner is kindly invited to contact the undersigned counsel at her earliest convenience.

Respectfully submitted,



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